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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Koji Kida

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FOLEY AND LARDNER LLP

SUITE 500

3000 K STREET NW

WASHINGTON, DC 20007

EXAMINER

DURAN, ARTHUR D

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.	Applicant(s)	
09/916,581	KIDA, KOJI	
Examiner	Art Unit	
Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-17 have been examined.

Response to Amendment

2. The Amendment filed on 3/26/07 is insufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12 and 17 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The word "expire" nor any of its derivatives could be found in the Applicant's Specification. No processing involving "valid" and "schedule" that was descriptive of claim 12 was found anywhere in the Applicant's Specification.

Also, Figures 4, 13, nor 31 support the features of claim 12.

Also, page 53 of the Applicants' Specification (Paragraph [411]) does not support claim 12.

Claim 12 states that an already expired advertisement can be copied by the user.

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However, the Applicant's Specification only supports that a user can copy an advertisement, which has not been deleted yet but which does have an upcoming deletion date, so that the user will have his own copy of the advertisement which will not be deleted in the future.

Also, Applicant's Specification states how only advertisements with a valid valid period are displayed ([332], Figures 6, 21).

So, Applicant's Specification only supports that a valid advertisement can be copied by the user so that the user's copy will not be deleted on a possibly upcoming deletion date.

Hence, there is no support for the Applicant's claim 12 as written.

Claim 17 is not supported. The closest support for claim 17 was found in Applicant's Paragraph [340] ([340]). However, this paragraph generally states how there is limited display space so a priority of advertisements is needed. A level of specificity with calculations as to space limitations and display areas is not supported.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1, 2, 4, 5, 8-15, and 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of [Goldhaber (5,794,210) OR in view of Wilkman (2002/0032609)].

Claims 1, 2, 5, 8-11, 13: Gerace discloses a server to which user terminals are connected via a network, this server comprising:

user schedule information storage means for storing user schedule information that has been input from the user terminals (col 9, lines 7-40; col 16, lines 35-67; col 22, lines 10-45; Fig. 4a, 'Travel Schedule');

schedule output means for outputting user schedule information from the aforementioned user schedule information storage means when there has been an access from a user terminal (col 3, lines 39-55; col 9, lines 7-40; col 16, lines 35-67; col 22, lines 10-45);

advertisement data storage means for storing advertisement data that has been input from an advertising provider (Fig. 2; Fig. 3a);

and means for associating the advertisement data stored in this advertisement data storage means with the user schedule information from the user schedule information storage means (Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest'; col 9, lines 7-40; col 16, lines 35-67; col 22, lines 10-45; Fig. 2; Fig. 3a);

wherein: the means for establishing this association includes interest estimation means for estimating, from the contents of the user schedule information, which advertisements the user will be interested in (Fig. 2; Fig. 3a; col 2, lines 1-35; Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest'; col 10, line 50-col 11, line 30);

this interest estimation means includes means for consulting a database in which has

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been stored information relating to what sort of advertising service a particular schedule item corresponds with, and for extracting a keyword serving to extract advertisement data that corresponds with the stored user schedule information (Fig. 2; Fig. 3a; col 9, lines 25-30; col 16, lines 36-55; Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest');

and there is provided advertisement presentation means which uses the keyword extracted by the interest estimation means to associate advertisement data that matches the keyword with the aforementioned user schedule information, and which presents the advertisement data in question along with the user schedule information (Fig. 2; Fig. 3a; col 9, lines 25-30; col 16, lines 36-55; Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest').

Additionally, Gerace discloses advertisement data including at least one keyword corresponding to an advertisement that is input by an advertiser, and that the advertisement keyword can be used for targeting the user (col 18, lines 1-10; col 16, lines 35-55; col 20, lines 9-19). Also, notice in Gerace that advertisements can be a form of agate information/content that is targeted to the user (col 2, lines 60-66). Hence, any of the tracking and/or targeting that occurs for content/information can also occur for advertisements. Also, notice that the advertiser can enter any targeting criteria to target users based on (see preceding citations). Also, notice that users can be targeted based on criteria/keywords match between the user and the advertisement such as Detroit, woman, 25 year old (these example keywords are from the preceding citations from Gerace). Also, notice that advertisements can be placed in messages/notices and targeted based on the message/notice (col 10, lines 46-51).

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Additionally, Gerace discloses a server which includes means for storing as user schedule information in the user schedule storage means, as a result of user input, advertisement data that has been presented along with user schedule information (col 6, line 57-col.7, line 40; Fig. 2; Fig. 3a; Fig. 3f; Fig. 3g; Fig. 4b).

Gerace further discloses that the user can indicate categories of interest (col 11, lines 45-56) and that advertisements can be targeted to the categories of interest/information type presented to the user (col 4, lines 29-36). Gerace further discloses that the user can indicate a sponsor interest type/list directly (Fig 3b, "Sponsor interest list (user choose from) DW Pepsi Coke").

Gerace does not explicitly disclose that the user can input a category of interest.

However, Goldhaber further discloses that the user can indicate advertisement categories of interest (Fig. 10; Fig. 11; col 6, lines 58-61; and throughout the Goldhaber disclosure).

Additionally, Goldhaber discloses advertisement titles (Fig. 11; col 7, lines 46-51).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's user can indicate/input advertisement categories of interest. One would have been motivated to do this in order to better present content/advertising of interest to the user.

Alternatively, Wilkman discloses that the user can indicate advertisement categories of interest (Paragraphs [103, 104, 105, 86]; Figures 1, 8, 11, 12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's user can indicate/input advertisement categories of

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interest. One would have been motivated to do this in order to better present content/advertising of interest to the user.

Also, note that Gerace discloses in the above citations targeting the user with advertising based on the schedule and/or the user interests.

Additionally, Gerace discloses the features of:

“b) a category for each of the advertisements, c) an advertisement title, and d) distribution conditions for distributing the advertisements”.

Gerace discloses categories for advertisements (Fig. 5c).

Also, Applicant's Specification states in regards to distribution conditions, “[0106] Distribution conditions (D105) is the field where the advertiser describes, as a set of conditions, the sort of user he wants to distribute the advertisement to. In this first embodiment, the advertiser inputs the following items: . . .”.

Gerace discloses distribution conditions (Fig. 3b; col 12, lines 20-56; col 14, line 65-col 15, line 10).

In regards to advertisement title, Gerace does not explicitly disclose advertisement title.

However, Gerace discloses show titles (col 26, lines 60-65) and content titles (col 7, lines 60-67). Gerace further discloses showing the ads that are included in a package (col 33, lines 55-57) and that ads are uniquely identified (col 12, lines 40-55; Fig. 3a).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's ad identification can include an advertisement title. One would have been motivated to do this in order to better identify advertisements.

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Additionally, as an example of this, Goldhaber discloses advertisement titles (Fig. 11; col 7, lines 46-51).

Claim 4: Gerace discloses a server according to claim 1, which includes means for storing as user schedule information in the user schedule storage means, as a result of user input, advertisement data that has been presented along with user schedule information (col 6, line 57-col 7, line 40; Fig. 2; Fig. 3a; Fig. 3f; Fig. 3g; Fig. 4b).

Gerace further discloses that the user can indicate categories of interest (col 11, lines 45-56) and that advertisements can be targeted to the categories of interest/information type presented to the user (col 4, lines 29-36). Gerace further discloses that the user can indicate a sponsor interest type/list directly (Fig 3b, "Sponsor interest list (user choose from) DW Pepsi Coke").

Gerace does not explicitly disclose that the user can input a category of interest.

However, Goldhaber further discloses that the user can indicate advertisement categories of interest (Fig. 10; Fig. 11; col 6, lines 58-61; and throughout the Goldhaber disclosure).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's user can indicate/input advertisement categories of interest. One would have been motivated to do this in order to better present content/advertising of interest to the user.

Alternatively, Wilkman discloses that the user can indicate advertisement categories of interest (Paragraphs [103, 104, 105, 86]; Figures 1, 8, 11, 12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's user can indicate/input advertisement categories of

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interest. One would have been motivated to do this in order to better present content/advertising of interest to the user.

Claim 9: Gerace discloses a storage medium in which have been stored programs which, by being installed in an information processing unit, implement the schedule and advertisement presentation system set forth in claims 1 to 4, the server set forth in claims 5 to 7, and the terminal equipment set forth in claim 8 (Fig. 1; Fig. 2; Fig. 3a; col 3, lines 39-67).

Claim 14, 15: Gerace discloses the above. Gerace further discloses advertisement valid time periods and advertisement distribution conditions (col 12, lines 21-56).

Claim 16: Gerace further discloses that distribution conditions include, gender, age, and geographic region that can be relevant demographic information for a user (Fig. 3b; col 27, lines 54-62).

Claim 17: The combination of the prior art discloses the above. Gerace further discloses displaying relevant ads in a priority ranking order due to limited display area (col 14, line 65-col 15, line 10).

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over [Gerace (5,848,396) in view of Wilkman (2002/0032609)] OR [Gerace (5,848,396) in view of Goldhaber (5,794,210) in view of Wilkman (2002/0032609)].

Claim 12: Also, with further regards to claim 12, the prior art discloses the above.

Gerace further discloses advertisement valid time periods and advertisement distribution conditions (col 12, lines 21-56).

Gerace does not explicitly disclose advertisement copying means for enabling the user to copy one or more advertisements to the user schedule, irrespective as to whether or not the advertisement valid time period has expired or will expire.

However, Wilkman discloses these features (Fig. 8; Fig. 1; Fig. 6; Fig. 7).

And, Wilkman further discloses that the user can indicate categories or features for promotions of interest such that the promotion can be sent to the user, sent to the user directly, or placed in the user's calendar ([91]). Wilkman further discloses that the promotions can be stored on the user device ([128]). Wilkman further discloses a calendar for displaying promotions of interest and/or a check box for selecting promotions (Fig. 8; [107]). And, Wilkman discloses selecting a promotion(s)/set of promotion(s) that are of interest to the user and are to be displayed to the user ([8]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wilkman's placing particular advertisements on the user schedule/calendar. One would have been motivated to do this in order to better present advertisements/content of interest to the user.

Also, note that in Gerace and/or Wilkman that the advertisement may or may not have an indication of expiration. Or, expiration can be set to an open ended, that is, far in the future date. Hence, expiration need not be a limiting criteria for what is presented, selected, or stored for the user.

5. Claims 3, 6, 7, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) [in view of Goldhaber (5,794,210) OR in view of Wilkman (2002/0032609)] and in further view of Desai (20050192008).

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Claims 3, 6: The prior art discloses a server according to the above.

Gerace further discloses that the advertisement data storage means stores geographical region data serving as a condition for presenting an advertisement;

a user whereabouts estimation means is provided for estimating which geographical region the user is currently in;

and the advertisement presentation means includes means for associating advertisement data that corresponds with this estimated user whereabouts with a user's schedule information, and for presenting the advertisement data along with the schedule information (col 10, line 50-col 11, line 30; col 6, lines 5-10; col 8, line 65-col 9, line 7; col 15, line 65-col 16, line 10; col 16, lines 30-36; col 9, lines 9-30; Fig. 4a, 'Travel Schedule', 'Specials advertised to areas of interest'; col 16, lines 36-55).

Gerace does not explicitly disclose estimating the users location/region from the user's schedule information in the user schedule information storage means.

However, from the preceding citations, Gerace discloses estimating the users location, using user location information to determine information of interest to the user, that user schedule information can be tracked, utilizing user schedule information to determine information of interest to the user, that user travel information can be tracked, that user travel information can be utilized for determining information of interest to the user, that all available information concerning a user, both active and passively obtained, historical, dynamic, and real-time can be tracked and utilized to present information of interest to the user.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Gerace can utilize user schedule information to estimate user region/location.

As a further example of this, Desai discloses targeted advertising based on profiles (Paragraph.[226]) and utilizing user schedule information to estimate user region/location:

‘[0098] . . . For example, the registered user 12 may provide access to profile information such as its favorite musical or play, its travel schedule and its online calendar to selected vendors 24. The vendors 24 may review the available time periods in the online calendar, review the travel schedule to determine the registered user's 12 location (such as city and hotel) on a given date, and recommend to the registered user 12 a local musical or play based on the registered user's 12 preferences.’

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Gerace can utilize user schedule information to estimate user region/location. One would have been motivated to do this in order to better utilize available user information to determine a parameter for presenting information of interest to the user.

Also, in regards to claim 16, the combination of the prior art discloses the geographic region characteristics as stated above. Also, Gerace further discloses that gender, age, and geographic region can be relevant demographic information for a user (Fig. 3b; col 27, lines 54-62).

Claim 7: Gerace discloses a server according to claim 5 or 6, which includes means for storing as user schedule information in the user schedule storage means, as a result of user input, advertisement data that has been presented along with user schedule information (col 6, line 57-col 7, line 40; Fig. 2; Fig. 3a; Fig. 3f; Fig. 3g; Fig. 4b).

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are not found persuasive.

Also, new claims 16 and 17 are rejected above.

On page 9, of the Applicant's Remarks dated 3/26/2007, Applicant states, "With such information, advertisements of interest to a user can be determined from other advertisements that will not be of interest to the user. None of the cited art of record teaches or suggests the use of the four separate things that are input by an advertiser in order that advertisements of the advertiser are provided to particular user's who meet those requirements."

Also, the new claim amendments state, in regards to the four separate things, "keyword corresponding to the advertisements that are input by an advertiser, b) a category for each of the advertisements, c) an advertisement title, and d) distribution conditions for distributing the advertisements".

However, Gerace discloses categories for advertisements (Fig. 5c).

Also, Applicant's Specification states in regards to distribution conditions, "[0106] Distribution conditions (D105) is the field where the advertiser describes, as a set of conditions, the sort of user he wants to distribute the advertisement to. In this first embodiment, the advertiser inputs the following items: . . .".

Gerace discloses distribution conditions (Fig. 3b; col 12, lines 20-56; col 14, line 65-col 15, line 10).

In regards to advertisement title, Gerace does not explicitly disclose advertisement title.

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However, Gerace discloses show titles (col 26, lines 60-65) and content titles (col 7, lines 60-67). Gerace further discloses showing the ads that are included in a package (col 33, lines 55-57) and that ads are uniquely identified (col 12, lines 40-55; Fig. 3a).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's ad identification can include an advertisement title. One would have been motivated to do this in order to better identify advertisements.

Additionally, Goldhaber discloses advertisement titles (Fig. 11; col 7, lines 46-51).

Please also note that the additional citations added preceding have also been added to the rejection above.

On page 9, Applicant states, "With respect to independent claim 12, that claim recites, among other things: advertisement copying means for enabling the user to copy one or more advertisements to the user schedule information, irrespective as to whether or not the advertisement valid time period has expired or will expire."

However, Examiner notes that claim 12 is a dependent claim and that claim 12 is dependent upon claim 1.

Also, please see the rejection of the current claim 12 above.

Also, please note the 35 USC 112 rejection of claim 12 above.

Also, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

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208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

And, Examiner notes that it must be presumed that the artisan knows something about the art apart from what the references disclose. *In re Jacobv*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. *In re Bozek*, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, USPQ 12 (CCPA 1977).

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Arthur Duran', written in a cursive style.

Arthur Duran
Primary Examiner
Art Unit 3622

4/16/2007